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09/002,485

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/002,485	12/31/97	LAL	

EXAMINER

ART UNIT	PAPER NUMBER
1642	5

DATE MAILED: 09/30/98

MP21/0930

MICHAEL C CERRONE
INCYTE PHARMACEUTICALS INC
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This is a communication from the examiner in charge of your application.
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OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire —0— month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☑ Claim(s) 1-23 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☐ Claim(s) _____ is/are rejected.
☐ Claim(s) _____ is/are objected to.
☑ Claim(s) 1-23 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☑ COVER SHEET FOR RESTRICTION/ELECTION BY FACSIMILE
☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 15 and 19, drawn to purified human signal peptide-containing proteins (SIGPs) and pharmaceutical compositions containing them, and therapeutic methods using the pharmaceutical compositions, classified in class 530, subclass 350 and class 424, subclass 184.1.

II. Claims 2-14, 22 and 23, drawn to purified polynucleotides encoding SIGPs, or hybridizing to polynucleotides encoding SIGPs, expression vectors, host cells containing the expression vectors, methods of producing SIGPs, and hybridization assays for the detection of polynucleotides encoding SIGPs, classified in class 536, subclasses 23.5 and 24.31, and class 435, subclass 6.

III. Claim 16, drawn to antibodies specific for SIGPs, classified in class 530, subclass 387.9.

IV. Claim 17, drawn to a purified SIGP agonist, classified in class 514, subclass 23.

V. Claims 18, 20 and 21, drawn to purified SIGP antagonists, and methods of treating or preventing cancer or an immune response using the antagonists, classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

The SIGP proteins of Group I, the nucleotides of Group II, the antibodies of Group III, the SIGP agonists of Group IV, and the SIGP antagonists of Group V represent separate and distinct inventions, as they are made by, and used in, separate methods; moreover, the search required for one group is not required for the other. Moreover, the therapeutic methods of Group I , the diagnostic methods of Group II and the therapeutic methods of Group V represent separate and distinct inventions, as they require different reagents and protocols, and have different outcomes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Election of Species

This application contains claims directed to the following patentably distinct species of the claimed invention: In Group I, the patentably distinct species are each of the signal peptide-containing proteins (SIGPs) represented by SEQ ID NOS: 1-77; in Group II the patentably distinct species are each of the polynucleotides represented by SEQ ID NOS: 78-154; in Group III, the patentably distinct species are each of the antibodies specific for a particular SIGP; in

Group IV the patentably distinct species are the agonists of particular SIGPs; and in Group V, the patentably distinct species are the antagonists of particular SIGPs.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is (703) 305-3704, and a Fax cover sheet is attached to this office action for your convenience. We encourage your participation in this pilot program. If you have any questions or suggestions please contact Donald E. Adams, Supervisory Patent Examiner, at Donald.Adams@uspto.gov or (703) 308-0570. Please limit the use of this dedicated Fax number to responses to Written Restrictions. Thank you in advance for allowing us to enhance our customer service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toni R. Scheiner whose telephone number is (703) 308-3983. The examiner can normally be reached Monday-Friday from 8:30 to 5:00.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

9/24/98

Toni R. Scheiner

TONI R. SCHEINER
PRIMARY EXAMINER
GROUP 1600

RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

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COMMENTS:_____

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IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE TELEPHONE NUMBER LISTED ABOVE.

IN COMPLIANCE WITH 1096 OG 30, THE FILING DATE ACCORDED EACH OFFICIAL FAX TRANSMISSION WILL BE DETERMINED BY THE FAX MACHINE DATE STAMP FOUND ON THE LAST PAGE OF THE TRANSMISSION, UNLESS THAT DATE IS A SATURDAY, SUNDAY, OR FEDERAL HOLIDAY WITHIN THE DISTRICT OF COLUMBIA, IN WHICH CASE THE OFFICIAL DATE OF RECEIPT WILL BE THE NEXT BUSINESS DAY.

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